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HEWLETT PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
3404 E HARMONY ROAD
P O BOX 272400
FORT COLLINS, CO 80528-9599

EXAMINER
DAVIS, DAVID DONALD

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/371,708
Filing Date: August 09, 1999
Appellant(s): LUFFEL ET AL.

MAILED

JAN 26 2007

Technology Center 2600

Bruce E. Dahl
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 7, 2003

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 3-7, 12-19 and 24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-13 and 15-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-24 of copending Application No. 09/337,802. Both sets of claims recite a translation apparatus for a translation device including a first elongate gear rack; a second elongated gear rack; a first drive pinion and a second drive pinion and a drive pinion apparatus.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3-7, 10-13, 15-19 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Tadokoro et al (US 6,166,877). Figure 19 of Tadokoro et al shows a modular data storage system for handling and storing data cartridges. Figure 19 also shows at least two laterally adjacent modular units; with each unit including a plurality of cartridge access devices 2. Figure 20 shows first and second elongated gear racks 32 aligned along a displacement path and positioned space-apart. Figure 19 of Tadokoro et al shows devices 2, which include racks 32, substantially in alignment with one another.

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Figures 20 and 21 show first and second drive pinions 41 mounted to cartridge access device 2 engaging respective racks 32. Pinion drive motor 34, as shown in figure 20 of Tadokoro et al, is operatively associated with pinions 41. Motor 34 rotates pinions 41 to move cartridge access device 2 among racks 32.

Figures 21 and 22 of Tadokoro et al show rack 32 including first and second elongated guide members 8 that extend along the displacement path substantially between first and second ends of racks 32. Bearings 33 mounted to cartridge device 2 engage first and second guide member 8. Also shown in figures 21 and 22 is first and second guide members 8 including first and second opposed bearing surfaces with bearings 33, which are mounted to device 2, slidably engaging the opposed bearing surfaces of member 8. Figures 20 of Tadokoro et al further shows motor 34 with worm and worm gear 39 attached to the shaft of motor 34 such that gear 39 is operatively connected to pinions 41.

(11) Response to Argument

In the second paragraph on page 22 appellants assert “Tadokoro’s two-piece guide member and gear rack arrangement teaches away from the **one-piece**, integral arrangement of the present invention.” Emphasis added.

Appellants’ arguments are not germane to the **claimed invention**. Appellants have not claimed a “one-piece” guide member and gear rack arrangement. Appellants claim an “integral” guide member and gear rack. The terms are not synonymous. It is well established that integral is defined to mean rigidly secured, fastened or welded. Integrally is not necessarily restricted to a one-piece article. [*In re Clark*, 102 USPQ 241 (CCPA); *In re Hotte*, 177 USPQ 326 (CCPA);

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In re Kohno, 157 USPQ 275 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Larson*, 144 USPQ 347 (CCPA 1965).] Also, *Webster's II: New Riverside University Dictionary* defines integral as "Essential for completeness" or "A complete unite: WHOLE". Neither the courts nor the dictionary define or suggestion the word "integral" to mean "one-piece", as purported by appellants.

In the first full paragraph on page 23, appellants maintain that the well established meaning of integral based on the definitions by the courts and the dictionary "would not be controlling in this case, as claim terms are to be construed in light of the teachings of the specification". It should be noted that the claim terms have been, with regard to the rejection, *supra*, and should be, as stated by appellant, construed in light of the teachings of the specification. However, as stated in MPEP § 608.01(o), "No term may be given a meaning repugnant to the usual meaning of the term."

Appellants continue in the first full paragraph on page 23 with the following statement:

"Reference to the currently pending specification makes clear that the guide member and gear racks are formed from the same member, thus giving meaning to the term 'integral' as that term is used in the currently pending claims."

Appellants then support the above statement with a quotation from specification, for example, on page 13, line 27 through page 14, line 2 it says "...both the lower and upper gear racks 20 and 22 are fabricated from sheet metal with the respective guide member portions 50 and 52 thereof comprising up-turned and down-turned edge portions, respectively." In this argument appellants are trying to impart yet another meaning to the term integral that is not supported by the courts or the dictionary definition. The term "formed from the same member" does not mean integral and

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the terms are not synonymous. Again, as stated in MPEP § 608.01(o), “No term may be given a meaning repugnant to the usual meaning of the term.”

Additionally, it should be noted that appellant has not recited a “means-plus-function” limitation to invoke 35 U.S.C. § 112, sixth paragraph. Therefore, appellants cannot impart the exact meaning from the specification into the term integral. The claims, as it has been stated, are to be construed in light of the specification.

Appellants have chosen to recite the term “integral” in the claims not “one-piece” or “formed from the same member”, and it is curious that appellants have chosen the term “integral” instead of “one-piece” or “formed from the same member”. Instead appellants have chosen to devote pages of arguments to the idea that the term integral does not mean what the courts and the dictionary says it means, which is encompassed by the two-pieces as taught by Tadokoro et al.

In the first full paragraph on page 25 and the paragraph bridging pages 25 and 26, appellants contend “Tadokoro’s vertical guide member is guided along the guide member 8 by wheels 33, not by slidable engagement.” *Webster’s II: New Riverside University Dictionary* defines “slide” as “To move over a surface while maintaining smooth, continuous contact”. Wheels 33 move over guide 8 while maintaining smooth, continuous contact.

In the second full paragraph on page 25, appellants maintain, “Tadokoro’s gear rack 32 is not a guide member.” A gear rack is a guide member and does guide because the gear (bearing or wheel) travels (or is guided) along the rack in the direction of the rack.

In the first and second paragraphs on page 26, appellants assert that “Tadokoro’s gear rack 32 does not provide a guidance function nor does Tadokoro disclose a bearing that contacts

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his gear rack.” First of all the claims do not require guidance. Assuming *arguendo*, the claims did a gear rack does provide guidance because the gear (bearing or wheel) travels (or is guided) along the rack in the direction of the rack. Secondly, a gear is a bearing, contrary to appellants’ assertion. *Webster’s II: New Riverside University Dictionary* defines “bearing” as “a device that supports, guides, and reduces the friction of motion between fixed and moving machine parts.” And the gear, bearing or wheel of Tadokoro does all of those things.

In the third paragraph on page 26, appellants assert that since the worm and worm gear are not **directly** attached to motor 34, “Tadokoro cannot anticipate claim 10.” It should be noted that appellants did not claim require direct attachment of the worm and worm gear.

On page 28 in the second full paragraph, appellants contend that Tadokoro does not disclose a power supply arrangement wherein “slave” units require power from a “master” unit. Contrary to appellants assertion figure 1 shows power supply 3 in “master unit” A for supply power to “slave” units B, C, D.

The remaining arguments on pages 28-31 have already been addressed in the paragraphs *supra*.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


David D. Davis

Primary Examiner

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ddd

December 13, 2006

Conferees

Hoa Nguyen 

Craig Renner 

DAHL & OSTERLOTH, L.L.P.

555 SEVENTEENTH STREET SUITE 3405

DENVER CO 8020